

REMARKS

Applicants respectfully request that the Examiner supply a copy of the Form 1449, mailed May 22, 2002 with an Information Disclosure Statement, indicating that references DZ-ED have been considered.

Claims 1-41 constitute the pending claims in the present application. Claim 1 has been amended. Support for the amendment may be found, for example, on page 32 lines 2-3 of the instant specification. No new matter has been added.

Amendment of the originally filed claims should in no way be construed as an acquiescence, narrowing, or surrender of any subject matter. The amendment is being made not only to point out with particularity and to claim the present invention, but also to expedite prosecution of the present application. Applicants reserve the option to prosecute the originally filed claims further, or similar ones, in the instant or subsequent patent applications.

Claim Rejections under 35 U.S.C. §112

Claims 5, 7, 10, 12-18, 21, 23, 28, and 29 stand rejected under 35 U.S.C. §112, second paragraph. Applicants respectfully traverse these rejection.

The Examiner asserts that the phrase “said biocompatible oil has a viscosity below about 140 cSt at 20 °C” renders claim 5 indefinite, and that the phrase “said biocompatible oil has a viscosity *below* about 45 cSt at 20 °C” renders claim 7 indefinite. Applicants respectfully note that claim 7 recites “said biocompatible oil has a viscosity *above* about 45 cSt at 20 °C” (emphasis Applicants). The Examiner further asserts that it is not clear what biocompatible oil would have such viscosity and the specification does not list any example of oil with such viscosity.

Applicants submit that “the recitation of specific numerical ranges in a claim does not raise an issue of whether a claim is definite.” M.P.E.P. 2173.05(c). Measurement of the viscosity is well within the scope of one of ordinary skill in the art. Non-limiting examples of viscosity measurement techniques include rheometer or force of gravity measurements. as

described in the specification, at, for example, page 4 lines 13-14. A person of ordinary skill is thus reasonably apprised of which oils, including those oils recited in the instant specification, claim 5 or claim 7 encompasses. Accordingly, withdrawal of these rejections under §112, second paragraph, is respectfully requested.

The Examiner asserts that the phrase “said biocompatible oil has a dielectric constant below about 20” renders claim 10 indefinite, and that the phrase “said biocompatible oil has a dielectric constant below about 5” renders claim 12 indefinite. The Examiner further asserts that it is not clear what biocompatible oil would have such dielectric constant and the specification does not list any example of oil with such constant.

Applicants submit that “the recitation of specific numerical ranges in a claim does not raise an issue of whether a claim is definite.” M.P.E.P. 2173.05(c). Measurement of the dielectric constant is well within the scope of one of ordinary skill in the art. A person of ordinary skill is thus reasonably apprised of which oils, including those oils recited in the instant specification, claim 10 or claim 12 encompasses. Accordingly, withdrawal of these rejections under §112, second paragraph, is respectfully requested.

The Examiner asserts that there is insufficient antecedent basis for the phrase “said biocompatible oil, and all other biocompatible oils” in claims 13-18, 21, 23, and 28-29.

Applicants respectfully submit that the phrase “all *other* biocompatible oils that may be present” does not require antecedent basis from claim 1. (Emphasis added.) The phrase is directed to any other biocompatible oils, in addition to the biocompatible oil of claim 1, that may or may not be present in the flowable pharmaceutical composition that is the subject of the rejected dependent claims. Applicants submit that “[i]f the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite.” MPEP 2173.05(e). Applicants assert that the scope of claims 13-18, 21, 23, 28, and 29 is clear to one skilled in the art. Accordingly, withdrawal of these rejections under §112, second paragraph, is respectfully requested.

Claim Rejections under 35 U.S.C. §102(b)

Claims 1-15, 17, 19-26 and 39-41 stand rejected under 35 U.S.C §102(b) as being anticipated by Takagishi et al. (US Patent 4,339,463). Applicants respectfully traverse this rejection. As the Examiner asserts, “Takagishi et al. teaches a suspension for filling the capsule comprising sesame oil and aspirin ...” Applicants respectfully contend that Takagishi does not disclose a pharmaceutically acceptable *salt* of an analgesic agent, as recited in claims 1, 39 and 41, and by reference dependent claims 2-15, 17, 19-26 and 40-41. (Emphasis Applicants) Because aspirin is not a “pharmaceutically acceptable salt of an analgesic agent,” Applicants respectfully request reconsideration and withdrawal of this rejection for claims 1-15, 17, 19-26 and 39-41.

Claims 1 and 27-38 stand rejected under 35 U.S.C §102(b) as being anticipated by Samejima et al. (JP 1001441, English abstract). The Examiner asserts that “Samejima et al. teaches a local anesthetic composition [that] may contain lidocaine and sesame oil.” Applicants respectfully assert that the English translation of Samejima does not disclose a flowable pharmaceutical composition comprising a biocompatible oil and a therapeutically effective amount of a pharmaceutically acceptable salt of an analgesic agent, wherein said salt of said analgesic agent is at most sparingly soluble in said pharmaceutical composition, wherein said flowable pharmaceutical composition is suitable for administration to a patient by injection, as recited in claim 1, and by reference dependent claims 27-38. (Emphasis Applicants). Because Samejima et al. does not show a composition that is *suitable* for administration to a patient by injection, Applicants respectfully request reconsideration and withdrawal of this rejection for claims 1, and 27-38.

Claim Rejections under 35 U.S.C §103(a)

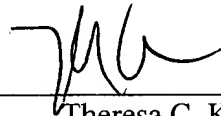
Claims 16 and 18 stand rejected under 35 U.S.C §103(a) as being unpatentable over Takagishi et al. (US Patent 4,339,463). Applicants respectfully traverse this rejection. Applicants respectfully submit that this reference, for the reasons discussed above, does not disclose all the limitations of the independent claims on which these rejected claims depend. Nor does this reference suggest all the limitations of claims 16 and 18, and the independent claims on

which these rejected claims depend. Accordingly, the Applicants respectfully request withdrawal of this rejection.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-832-1000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this application be charged to **Deposit Account No. 06-1448**.

Respectfully submitted,
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